

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:
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WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing
(day/month/year) 16 NOV 2004

Applicant's or agent's file reference
38187-274PCT

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/US04/19129

International filing date (day/month/year)
14 June 2004 (14.06.2004)

Priority date (day/month/year)
13 June 2003 (13.06.2003)

International Patent Classification (IPC) or both national classification and IPC
IPC(7): A61B 5/00 and US Cl.: 600/309, 584

Applicant
PELIKAN TECHNOLOGIES, INC.

1. This opinion contains indications relating to the following items:

- Box No. I Basis of the opinion
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV Lack of unity of invention
- Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

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WRITTEN OPINION OF THE
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Box No. 1 Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

a sequence listing

table(s) related to the sequence listing

b. format of material

in written format

in computer readable form

c. time of filing/furnishing

contained in international application as filed.

filed together with the international application in computer readable form.

furnished subsequently to this Authority for the purposes of search.

3. In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

**WRITTEN OPINION OF THE
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Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims <u>1-23</u>	YES
	Claims <u>NONE</u>	NO
Inventive step (IS)	Claims <u>10, 14-16, 20-23</u>	YES
	Claims <u>1-9, 11-13, 17-19</u>	NO
Industrial applicability (IA)	Claims <u>1-23</u>	YES
	Claims <u>NONE</u>	NO

2. Citations and explanations:

Claims 1-9, 11-13, and 17-19 lack an inventive step under PCT Article 33(3) as being obvious over Aceti et al. Aceti et al. teach a monitor having a housing containing a plurality of needles, each separately extendable from the housing and in communication with reaction chambers. Optical measurements from the reaction chambers provide data on the measured analytes. The choice of reagent determines the assay that will be performed. Although Aceti et al. disclose monitoring of glucose as their preferred embodiment, it would have been within the skill level of the art at the time of the invention to provide additional assay reagents having properties as described by Aceti et al. (Assay Reagents - column 9 - 10) to allow the device to perform measurements for multiple analytes of interest with a single measurement system.

Claims 10, 14-16, and 20-23 meet the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest any of: performing many tests with one penetrating member/analyte detecting member combination, the various configurations of claims 14 - 16, or a separate storage area with a sensing area and another storage area with the enzyme therein arranged so that fluid flows to the enzyme area and then the sensing area.

Claims 1-23 meet the criteria under PCT Article 33(4), because the subject matter claimed can be made or used in industry.

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Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

Claims 17 - 19 are objected to under PCT Rule 66.2(a)(iii) as containing the following defect(s) in the form or contents thereof: the claims do not end with periods.

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Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the questions whether the claims are fully supported by the description, are made:

Claims 11, 12, 18, 19, and 21 are objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 6 because the claims are indefinite for the following reason(s): With regard to claim 11, it is unclear what provides basis for the phrase "each segment". With regard to claim 12, it is unclear what Applicant intends to claim, as the claim is merely a series of unrelated phrases. With regard to claim 18, it is unclear what further structural limitation Applicant provides, as the claim implies a process is occurring. Claim 19 is unclear. With regard to claim 21, the phrase "at conforming to" is unclear.

NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under Article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments and any accompanying statement, under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the time of filing the amendments (and any statement) with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments (and of any statement) and, where required, a translation of such amendments for the procedure before that Authority (see Rules 55.3(a) and 62.2, first sentence). For further information, see the Notes to the demand form (PCT/IPEA/401).

Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see the *PCT Applicant's Guide*, Volume II.